

### REMARKS

This paper is submitted in reply to the Office Action dated February 3, 2003, within the three-month period for response (as May 3, 2003 is a Saturday). Reconsideration and allowance of all pending claims are respectfully requested.

In the subject Office Action, claims 1 and 19 were objected to based on informalities. In addition, claims 9, 11-12, and 19 were rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 6,020,884 to MacNaughton et al. Furthermore, Claims 1-2, 5-6, 13-18, 20-22, and 25-36 were rejected under 35 U.S.C. § 103(a) as being unpatentable over MacNaughton et al. in view of U.S. Patent No. 5,040,891 to Wagner et al., claims 3-4 were rejected under 35 U.S.C. § 103(a) as being unpatentable over MacNaughton et al. in view of Wagner et al. in further view of "Chat Comp: Lobby," Yahoo!, <http://chat.yahoo.com>, downloaded 11/18/98, (hereinafter Yahoo), and claims 7-8 were rejected under 35 U.S.C. § 103(a) as being unpatentable over MacNaughton et al. in view of U.S. Patent No. 6,430,567 to Burr ridge.

Applicants respectfully traverse the Examiner's rejections to the extent that they are maintained. In addition, in this paper, Applicants have amended claims 1 and 19 to overcome the Examiner's objections. Applicants respectfully submit that no new matter is being added by the above amendments, as the amendments are fully supported in the specification, drawings and claims as originally filed.

The Examiner's objections and rejections will now be addressed in the order in which they appear in the Office Action.

### Claim Objections

First in the subject Office Action, the Examiner objected to claim 1 based upon improper grammar, specifically the word "identify" in part (c) should have been "identity." Additionally, claim 19 was objected to because two sections in the claim were labeled as "(b)" when the second "(b)" section should have been labeled as "(d)." The

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Examiner will note that Applicants have corrected both matters addressed in claims 1 and 19, respectively, as required by the Examiner. Withdrawal of the objections is therefore respectfully requested.

Rejections Under 35 U.S.C. §102

Next, turning to the §102 rejections, and in particular to the rejection of claim 9, this claim was amended in Applicants' previous response to independent form, including the feature of maintaining a navigation history for other users, such that a user viewing a hypertext document could be notified of a set of hypertext documents in the navigation history for another user viewing the same hypertext document.

In rejecting the claim, the Examiner relies on col. 9, lines 6-51 of MacNaughton et al. for allegedly disclosing notifying a first user of a set of hypertext documents in a navigation history for a second user. However, Applicants can find no text in the cited passage that discloses this claimed feature. The passage does disclose a tracking server that tracks the activities of users in a community, including the web pages accessed (col. 9, lines 38-43). Moreover, the passage does disclose the concept of notifying a user of the presence of other users in a community (col. 9, lines 31-34).

However, while both tracking the activities of users, and notifying users of the presence of other users, are both disclosed, there is no disclosure in MacNaughton et al. of the specific concept of notifying one user of a set of hypertext documents in the navigation history of another user. Of note, the only notifications specified in the cited passage are of "the presence of members within a community at a given time and information regarding chat sessions currently in progress" (col. 9, lines 31-34), and aggregated data that may be "reported to community members (e.g., results of voting on a particular issue)" (col. 9, lines 50-51).

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As such, Applicants respectfully submit that claim 9 is novel over MacNaughton et al., as the reference does not disclose the notifying one user of a set of hypertext documents in the navigation history of another user.

Moreover, Applicants respectfully submit that claim 9 is also non-obvious over MacNaughton et al. and the other prior art of record, as there has been no evidence of any motivation to modify MacNaughton et al. to incorporate such a feature.

In particular, the only notification in MacNaughton et al. that is even arguably relevant is the notification of a current web page that a particular user is visiting. That a current web page is reported to other users, however, falls far short of suggesting the reporting of where a user has previously visited.

In addition, the fact that MacNaughton et al. discloses that the web pages accessed by users are tracked, falls short of disclosing or suggesting the notification of users of the web pages accessed by other users. Applicants would expect that a significant amount of data would be tracked by the MacNaughton et al. system, and that not all of that information would necessarily be reported to all users. Simply tracking certain data does not mean that all of that data will be made available to other users. Indeed, it is likely that certain data about a user must be kept confidential from other users for privacy concerns.

As a result, Applicants respectfully submit that claim 9 is also non-obvious over MacNaughton et al. and the other prior art of record. Reconsideration and allowance of claim 9 are therefore respectfully requested.

Next, with respect to claim 11, this claim was previously amended to independent form, and included the feature of displaying an indication of whether a hypertext link in a document viewed by a first user targeted a hypertext document in the navigation history of a second user. Thus, simply by viewing the link and its associated indication, a user can immediately discern whether another user has already visited that link.

In rejecting the claim, the Examiner relies on col. 9, line 53 to col. 10, line 32 of MacNaughton et al. for allegedly disclosing these additional features. However,

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Applicants can find no disclosure in this cited passage that appears to be even arguably relevant to the display of an indication of whether a hypertext link in a document is in the navigation history of another user. The passage at col. 10, lines 17-32 appears to disclose various annotation, messaging, chat, and membership functions; however, none of the disclosed functions appear to be analogous to the claimed feature. Certainly, if the Examiner can point to any particular language in the cited passage that the Examiner considers relevant to displaying an indication of whether a hypertext link is for a hypertext document in the navigation history of another user, Applicants would appreciate an explanation in the Examiner's next communication. Otherwise, Applicants respectfully submit that the Examiner has failed to establish any lack of novelty on the part of claim 11. Furthermore, there is no support on the record for any motivation in the art to modify MacNaughton et al. to incorporate the features recited in claim 11. Accordingly, Applicants respectfully submit that claim 11 is patentable over the prior art of record, and request reconsideration and allowance of this claim, as well as of claim 12, which depends therefrom.

Next, with respect to claim 19, this claim was previously amended to independent form, including the feature of displaying a combined list of favorite links that is associated with only those users that are currently viewing the same hypertext document. Therefore, claim 19 supports the ability to pool the favorite links of multiple users into a combined list, but with the list limited to the links associated with those users that are currently viewing the same hypertext document.

In rejecting this claim, the Examiner relies on col. 7, line 57 to col. 8, line 57 and col. 9, line 27 to col. 10, line 32, for allegedly disclosing the recited combined list of favorite links. However, as with the rejection of claim 11, Applicants can find no disclosure in these passages that appear to be at all relevant to this claimed feature. Again, if the Examiner feels that any particular text in the cited passages discloses this claimed feature, Applicants would appreciate an explanation of such in the Examiner's

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next communication. Otherwise, Applicants respectfully submit that the Examiner has failed to establish any lack of novelty on the part of claim 19. Furthermore, there is no support on the record for any motivation in the art to modify MacNaughton et al. to incorporate the features recited in claim 19. Accordingly, Applicants respectfully submit that claim 19 is patentable over the prior art of record, and request reconsideration and allowance of this claim.

#### Rejections Under 35 U.S.C. §103

Next, turning to the §103 rejections, and specifically to the rejection of independent claim 1, this claim was previously amended to additionally recite the concept of a saved user list that identifies users that are accessing the same hypertext document, and that may be updated in response to user input to add and remove users to and from the list.

As noted in Applicants' previous response, the saved user list recited in claim 1 is maintained on behalf of a particular user, and is capable of being managed by that user.

In rejecting claim 1, the Examiner admits that the concept of a saved user list is not disclosed in MacNaughton et al. (February 3, 2003 Office Action, ¶2). However, the Examiner relies on Wagner to allegedly teach maintaining a saved user list for a user with support for adding and removing users to and from the list in response to user input, citing col. 56, lines 46-61.

The cited passage in Wagner, however, deals only with "dial lists" used in a computer videoconferencing system. Given the application in videoconferencing, it is assumed that these "dial lists" are analogous to "speed dial" buttons on a telephone, as they provide lists of potential callees for a videoconferencing session.

While an argument could potentially be made that the "dial lists" of Wagner are analogous to "saved user lists", it is important to note that claim 1 specifically recites that the claimed saved user list identifies at least a second user such that the first user is

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notified of the identity of any user in the saved user list that is accessing the same hypertext document.

There is no disclosure or suggestion in Wagner that a "dial list" may be used to identify users that are accessing the same hypertext document. In fact, given the application of Wagner in terms of videoconferencing, it seems highly unlikely that Wagner would benefit from any identification of the users that are accessing the same hypertext document. Instead, it appears Wagner is merely directed to facilitating the selection of callees for a videoconferencing session, which is entirely irrelevant to the concept of a saved user list as recited in claim 1.

As noted previously, MacNaughton et al. likewise does not disclose or suggest user-maintained saved user lists. In fact, the reference teaches away from such lists given the community-centric nature of the MacNaughton et al. system. The disclosure of user-specific dial lists in Wagner, irrespective of the fact that such lists are not relevant from the perspective of tracking those users that are accessing the same hypertext document, are insufficient to overcome the focus on collective (i.e., non-user specific) lists in MacNaughton et al.

Applicants respectfully submit that one of ordinary skill in the art would simply not be motivated by Wagner to modify MacNaughton et al. to support user-maintained saved user lists that identified those users that were accessing the same hypertext document. As such, it appears the Examiner is improperly relying on hindsight to combine the disparate teachings of the references.

Applicants therefore respectfully submit that claim 1 is non-obvious over the prior art of record. Reconsideration and allowance of claim 1, as well as of claims 2-6, 13-18 and 20-22 which depend therefrom, are respectfully requested.

Next, with respect to independent claim 7, this claim was previously amended to independent form, including the feature of notifying one user of the location of another hypertext document currently being viewed by another user.

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In rejecting claim 7, the Examiner now admits that MacNaughton et al. does not disclose notifying one user of the location of another hypertext document currently being viewed by another user. Instead, the Examiner relies on Burrige, and in particular, the passage at col. 2, lines 7-19, for allegedly disclosing this recited feature.

The cited passage in Burrige, however, can at most be read to disclose the display of a list of users that are currently in a group of chat rooms that share a common category. *See, e.g.*, Burrige, col. 2, lines 16-19, ("Within each room, the user can see a list of users within that room and a list of all of the users within the selected category").

Claim 7 differs from Burrige, however, in that claim 7 is focused on notifying a user of the location of a hypertext document being viewed by another user, while Burrige is focused on notifying a user of other users that are currently in a collection of chat rooms. There is no disclosure in Burrige that the displayed list of users within the selected category lists which specific chat rooms those users are currently in.

Put another way, if in Burrige a certain category had 3 chat rooms, and users A, B and C were in chat room 1, users D and E were in chat room 2, and users F and G were in chat room 3, the list presented to the user would simply list users A-G as being in the category's chat rooms. By simply listing users A-G, however, no information would be provided as to which users were in which chat rooms. As such, the user would not be notified of the locations of (or even the identities of) the various chat rooms those users were currently in.

As such, Applicants respectfully submit that Burrige fails to disclose or suggest the concept of notifying one user of the location of another hypertext document currently being viewed by another user. Given also that this feature is not disclosed or suggested by MacNaughton et al., Applicants respectfully submit that the combination of MacNaughton et al. and Burrige fails to render claim 7 obvious. Reconsideration and allowance of claim 7, and of claim 8 which depends therefrom, are therefore respectfully requested.

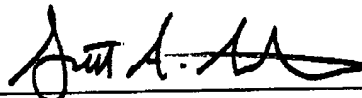
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Finally, with respect to independent claim 25, this claim was previously amended to recite the concept of a user-maintained saved user list of users that are accessing the same hypertext document. As such, claim 25 is patentable over the prior art of record for the same reasons as presented above for claim 1. Reconsideration and allowance of claim 25, and of claims 26-36 which depend therefrom, are therefore respectfully requested.

In summary, Applicants respectfully submit that all pending claims are novel and non-obvious over the prior art of record. Reconsideration and allowance of all pending claims are therefore respectfully requested. If the Examiner has any questions regarding the foregoing, or which might otherwise further this case onto allowance, the Examiner may contact the undersigned at (513) 241-2324. Moreover, if any other charges or credits are necessary to complete this communication, please apply them to Deposit Account 23-3000.

5 MAY 2003  
Date

Respectfully submitted,



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